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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/747,950 | 12/27/2000 | Richard C. Zorn | 263-2290 | 3169 |

7590 11/01/2004

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| EXAMINER |
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MYHRE, JAMES W

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| ART UNIT | PAPER NUMBER |
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3622

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,950

Applicant(s)

ZORN, RICHARD C.

Examiner

James W Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed on September 1, 2004 has been considered but is ineffective to overcome the DeBruin-Ashton (6,014,629) and Manley et al (5,186,443) references. The amendment amended several paragraphs within the specification and Claims 1, 3, 5, 7, and 9-11 to correct typographical deficiencies. The currently pending claims considered below are Claims 1-11.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 4-6, and 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by DeBruin-Ashton (6,014,629).

Claims 1, 5 and 9: DeBruin-Ashton discloses a method for targeting promotions to subscribers, comprising:

a. Creating brochure templates with variable print fields (col 9, line 66 – col 10, line 67);

b. Accessing a subscriber database and sorting subscribers to create a sub-list of subscribers based on sorting criteria (col 7, lines 1-15 and col 9, lines 24-27).

c. Printing a personalized brochure for each subscriber using the appropriate brochure template (col 13, lines 39-47); and

d. Attaching and sending each of the printed brochures to the appropriate corresponding subscriber (col 13, lines 39-47).

The Examiner notes that DeBruin-Ashton's sorting of the subscribers based on whether or not the subscriber wears eyeglasses is the equivalent of claimed creation of two sub-lists of subscribers.

Claims 2, 6, and 10: DeBruin-Ashton discloses a method for targeting promotions to subscribers as in Claims 1, 5, and 9 above, and further discloses the sorting criteria relates to a characteristic of the subscribers, such as a previous relationship with a particular physician, wearing eyeglasses, living within a certain region, etc. (col 7, lines 1-15 and col 9, lines 24-27).

Claims 4 and 8: DeBruin-Ashton discloses a method for targeting promotions to subscribers as in Claims 1 and 5 above, and further discloses that at least 25% of the brochures include editorial and/or public service information (Figure 3B, items 340).

The Examiner notes that the type of information printed on the brochure does not affect the method steps on customizing the brochure and, thus, is given little if any patentable weight. However, DeBruin-Ashton's lists of health care providers within the vicinity of the subscribers is considered to be public service information and is shown to cover the majority of the printed page in the brochure.

Claim 11: DeBruin-Ashton discloses a method for targeting promotions to subscribers as in Claim 10 above, and further discloses including a coupon in the printed version of the brochure (Figure 3B, items 346 and col 9, lines 18-27). DeBruin-Ashton further discloses that the coupon is selected and printed based on the personal criteria of the subscriber, i.e. the coupons for a discount on optical services or products shown in Figure 3B are only printed in the brochures being sent to subscribers who wear eyeglasses.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruin-Ashton (6,014,629) in view of Manley et al (5,186,443).

Claims 3 and 7: DeBruin-Ashley discloses a method for targeting promotions to subscribers as in Claims 2 and 6 above, and further discloses that the sorting criteria relates to a characteristic of the subscriber. However, it is not explicitly disclosed that the characteristic relates to the subscriber's fiscal credit. Manley discloses a similar method for sending personalized printed material to subscribers, and further discloses that the personalization and sorting are based on the subscriber's fiscal credit, i.e. the possession of a particular credit card. Therefore, it would have been obvious to one

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having ordinary skill in the art at the time the invention was made to use the subscriber's fiscal credit as at least one of the sorting criteria being used by DeBruin-Ashton. One would have been motivated to use this type of criteria in DeBruin-Ashton in order to select physicians which the subscriber can afford, e.g. one who accepts the health insurance held by the subscriber.

Response to Arguments

6. Applicant's arguments filed September 1, 2004 have been fully considered but they are not persuasive.

The Applicant argues that DeBruin-Ashley does not teach attaching the printed brochures to copies of a periodical and sending both to the subscriber to which the brochure is addressed (page 12). The Examiner notes that DeBruin-Ashley discloses that physician directories are normally published periodically ("e.g. annually or quarterly")(col 3, lines 3-7) In order to overcome the cost of publishing such expensive and voluminous directories, DeBruin-Ashley tailors the periodical (physician directory) to the individual subscriber and further attaches one or more advertisements or other information such as photographs or maps (i.e. brochures) to the periodical, also tailored to the individual subscriber (e.g. subscriber's geographic location and profile – eyeglass wearers). Once the two have been merged and printed, the completed periodical with attached brochures are forwarded to the respective subscriber, then the process is repeated for the next subscriber (col 13, lines 45-47). Thus, the targeted advertising

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brochures are attached to (merged) with the periodical and sent to the subscriber to whom the brochure is addressed.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or

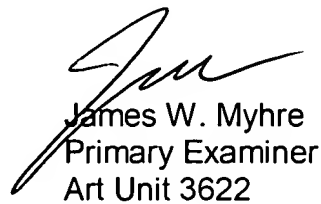
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Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

Handwritten signature of JWM in black ink.

October 26, 2004

Handwritten signature of James W. Myhre in black ink.

James W. Myhre
Primary Examiner
Art Unit 3622